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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/570,022	02/24/2006	Glenn Mark Wakefield		1125

7590  
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1416 East Casmien Street  
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EXAMINER
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LEUBECKER, JOHN P

ART UNIT	PAPER NUMBER
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3739

MAIL DATE	DELIVERY MODE
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09/10/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/570,022	<b>Applicant(s)</b> WAKEFIELD, GLENN MARK	
	<b>Examiner</b> John P. Leubecker	<b>Art Unit</b> 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 11-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 February 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 3739

***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, a capsule with a gyroscope and accelerometer (claim 11), imaging lenses (claim 14), magnetic sensors (claim 15), a small generator (claim 16), all the sensors of claim 18, and the structure of claim 19, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

2. Applicant is reminded of the proper content of an abstract of the disclosure.

Art Unit: 3739

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

3. The abstract of the disclosure is objected to because it generally refers to the purported merits or speculative applications of the invention and does not provide an adequate statement of the technical disclosure. Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 11-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 3739

The scope of independent claim 11 is indefinite since it is not clear whether this claim is intended to encompass three separate capsules, a single capsule with all features listed from each capsule, or a single capsule that may or may not have any of the features listed for each of the capsules. In addition, since any capsule must fall into "with or without" an external physical connection, it is not clear as to the difference between the first two recited capsules, assuming a difference was intended. The phrases "whose size and capabilities will depend on the design and application" and "will depend on the design and application" is indefinite since size, capabilities and design are indeterminant and appear to be left up to Applicant to determine as necessary. Furthermore, term "field generating structures" lacks antecedent basis.

As to claims 12-20, the claims are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited. For instance, claim 12 fails to further limit the invention of claim 11--it does not present any new structure, does not further define structure of claim 11 and appears to only purport an intended use. Claims 13, 14 and 15 recite that one of the capsules "may have" features such as light sources, sensors, etc., but fail to set forth if the capsule does include any or all of these features (perhaps Applicant meant that the capsule "includes one or more of the following"). Claim 16 appears to be an improper method step (perhaps Applicant intended the claim to read:-- wherein one of the capsules further comprises a power source and a small generator disposed such that an external magnetic field will operate the generator to recharge the power source--). Such language would also correct

Art Unit: 3739

antecedent basis issues with the terms “field generating structures” and “power source”. As to claim 17, it is not clear what the “instrument” is and what structure is encompassed by it "allowing for" the recited functions. The same applies to claims 18 and 19. Claim 20 appears to be improperly reciting method steps.

***Claim Rejections - 35 USC § 102 and 103***

6. Due to the severity of the indefiniteness in the claims, prior art could not be accurately applied to the claims. Presumptions will not be made as to the intended scope of the claims. However, the Examiner would like to point out two references that teach many of the potential features mentioned in the claims.

Applicable to the claims as best understood, Alfano et al. (U.S. Pat. 6,240,312) disclose a magnetically controlled (col.5, lines 16-20) capsule that can be physically connected (Figs.1 la, 1 lb) or not physically connected (Fig.2), including an imaging device/electromagnetic wave detector (25), a light source (23), a laser (19) which could allow for biopsy/excision, a wireless communication system (21), and a power generation system (27, col.5, lines 48-65).

Applicable to the claims as best understood, Yokoi et al. (US 2003/0023150) disclose a magnetically responsive capsule (note [0160]) including magnets (43a,43c), light sources (19), imaging lenses (16), image (electromagnetic) sensor (18), antenna (31), memory ([0179]), transmitting/receiving circuit (30), power source (29), power lines (23), and sensors such as temperature, pH, and position ([0179]).

*Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 20040138552 A1 Harel, Alex et al.  
US 20040050394 A1 Jin, Sungho  
US 20030020810 A1 Takizawa, Hironobu et al.  
US 20020055734 A1 Houzego, Peter J. et al.  
US 5681260 A Ueda; Yasuhiro et al.  
US 20030060734 A1 Yokoi, Takeshi et al.  
US 20030023150 A1 Yokoi, Takeshi et al.  
US 20020198439 A1 Mizuno, Hitoshi  
US 6240312 B1 Alfano; Robert R. et al.

8. An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

A listing of registered patent attorneys and agents is available on the USPTO Internet web site <http://www.uspto.gov> in the Site Index under "Attorney and Agent Roster." Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U. S. Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450

Art Unit: 3739

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (571) 272-4769. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John P. Leubecker/  
Primary Examiner  
Art Unit 3739

jpl